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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/890,203	10/05/2001	Richard Humpert	60174-021	8894

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Raymond E Scott
Howard & Howard
Pinehurst Office Center Suite 101
39400 Woodward Avenue
Bloomfield Hills, MI 48304-5151

EXAMINER

SAETHER, FLEMMING

ART UNIT	PAPER NUMBER
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3679

DATE MAILED: 12/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/890,203

Applicant(s)

HUMPERT ET AL.

Examiner

Flemming Saether

Art Unit

3679

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 October 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) 3,7,8,10,12,15,19,20 and 22-32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-6,9,11,13,14,16-18 and 21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Election/Restriction

Claims 3, 7, 8, 10, 12, 15, 19, 20 and 22-32 remain withdrawn from further consideration pursuant to 37 CFR 1.142(b).

Specification

The disclosure is objected to because of the following informalities: the title of the invention is not descriptive, the headings to the various sections of the disclosure are lacking.

Appropriate correction is required.

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: "function element" as in claim 1. Applicant is reminded that all the elements of the claims are required to have antecedent basis in the description. In that regard, the "function element" was not found in the description.

Claim Rejections - 35 USC § 112

Claims 1, 2, 4-6, 9, 11, 13, 14, 16-18 and 21 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In the claims "ring-like", "plate-like" and "pot-like" are indefinite because it is unclear what is intended to like a ring, plate or pot. Also, in the claims "for example" continues to be indefinite. In

Art Unit: 3679

claim 21, "for example" continues to be indefinite as does "one or more". In claim 6, it should be clarified if the end face is deformable or not deformable. The claims still should be further reviewed or should be reviewed again to correct any other areas of indefiniteness particularly since the application is based on a foreign parent.

Claim Rejections - 35 USC § 102

Claims 1, 2, 4, 5, 6, 16-18 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Herb (US 4,560,311). In the embodiment of Figs. 1 and 2, Herb discloses a function carrier comprising a function element formed as a bolt element (1c) having a head (1a) at one end with a concave fillet (1d) transitioning from the shaft to the head and, a rivet sleeve (2) received on the shaft and moveable in the axial direction having a deformable region (2d) for deformation by the concave fillet (see Fig. 2). The concave fillet being curved in the circumferential direction. The sleeve further having a non-deformable ring portion (the portion between 2b and 2c) having a flat perpendicular sliding end face (2b) for transmission of a rivet force, a rectangular cross section and separated from the deformable portion by a shoulder portion (2c) but, having a continuous tubular inner wall.

Claims 1, 2, 4, 5, 6, 9, 11, 13, 16-18 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Velasco (4,797,044). Velasco discloses a function carrier comprising a function element formed as a bolt element (1) having a head (not labeled) at one end including a concave fillet transitioning from the shaft to the head

Art Unit: 3679

and, a rivet sleeve (3) received on the shaft and moveable in the axial direction having a deformable region (at the distal end region thereof) for deformation by the concave fillet (see Fig. 8). The sleeve having a "ring-like" portion, a flat perpendicular sliding end face for transmission of a rivet force, a rectangular cross section and separated from the deformable portion by a shoulder portion (shown as member 4) but, having a continuous tubular inner wall. Velasco further discloses the function element to have a tool receiving recess (see Fig. 1, 7-9) for torque transmission and, with security features against rotation formed on the fillet (as see by grooves formed thereon). The concave is curved in the circumferential direction.

Claim Rejections - 35 USC § 103

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Herb or Velasco as applied to claim 1 above, and further in view of Fischer (US 4,943,195). Fisher teaches the function element to be equipped with features providing security against rotation on the end of the head remote from the shaft to prevent (13, or 17). At the time the invention was made, it would have been obvious for one of ordinary skill in the art to provide the device of either Herb or Velasco with rotation preventing features as disclosed in Fischer in order to prevent rotation of the function element which would provide for easier installation.

In response to Applicant's Remarks:

Applicant failed to correct the title and provide antecedent basis for the claim terminology. The title should be descriptive and, as discussed above, every element of the claims is required to have antecedent basis in the description.

Applicant also failed to correct all the areas of indefiniteness associated with the claims. Applicant should review all the claims to ensure they conform to current US practice. The claims are required to clear and concise so that there is no ambiguity as to what applicant regards as the invention.

Applicant argues that prior art rejections; Applicant argues the claims are allowable over Herb because Herb includes a notch which the sleeve of the instant invention does not have. In response, the issue of a notch is irrelevant because the claims as written do not preclude the inclusion of a notch. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant argues that the prior art, neither Herb nor Velasco, discloses the *rounded* concave fillet [as amended]. In response, with the claims given their broadest reasonable interpretation, the prior art reads on the concave fillet being rounded since it is rounded in the circumferential direction as noted above.

Art Unit: 3679

Applicant noted that Herb is intended for use in concrete whereas the instant invention is for use with a plate. In response, as with the notch, the use with a plate is not in the claims. Further, applicant is reminded that an intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Applicant next argues the claims define over Velasco since there are two differences. First, Velasco does not disclose a rounded concave fillet. In response, as discussed above, the fillet in Velasco is rounded in the circumferential direction.

Secondly, applicant argues that the instant invention is a one piece sleeve while the sleeve in Velasco is a two piece sleeve. In response, the claims do not require a one piece sleeve and as discussed above. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims.

As with Herb, applicant notes that Velasco is intended for use in concrete whereas the instant invention is for use with a plate. In response the use with a plate is not in the claims. Further, applicant is reminded that an intended use of the claimed invention must result in a structural difference between the claimed invention and the

Art Unit: 3679

prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Applicant lastly argues that the reference to Fischer fails to remedy the deficiencies of Herb and Velasco. In response, Fischer is not relied upon to remedy the alleged deficiencies but, is simply relied upon for its' features providing security against rotation.

In conclusion, the examiner maintains that the claims require further revision in order to comply with 35 U.S.C. 112, second paragraph and, that the references applied read on the *claims* [emphasis] of the instant application when given their broadest reasonable interpretation. However, to expedite this application, the applicant should consider the reference to Kiabach (US 6,012,887) because it shows a rounded concave fillet (at 7) similar to that disclosed in the instant application.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

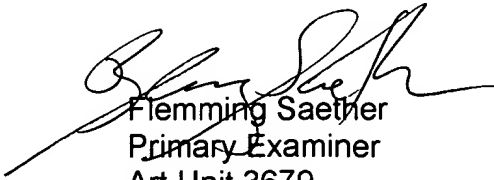
• Art Unit: 3679

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Flemming Saether whose telephone number is 703-308-0182. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynne Browne can be reached on 703-308-1159.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.


Flemming Saether
Primary Examiner
Art Unit 3679